

REMARKS

Claims 1-28 are pending in the application. Claims 1-18 and 20-28 have been allowed.

In the Action, the Examiner rejects claim 19 under 35 USC 102(a) as being unpatentable in view of Visser (U.S. Pat. No. 6,577,219). Applicants respectfully disagree that Visser is prior art to this application.

Visser has a filing date of June 29, 2001. Applicants avert that the present invention was reduced to practice by September 30, 2000, i.e. before the June 29, 2001 filing date of Visser. In support of this assertion Applicants submit:

1. A declaration of prior invention under 37 CFR 1.131
2. Invention disclosure signed by Applicants on May 17, 2000. In section 3 of sheet 2 ("Proof on Conception"), a statement is present that the present invention was written or drawings made on January 10, 2000.
3. A Final Report dated November 2000. On page 71 of the Final Report, a Figure 82 is presented depicting a photograph of the present invention on a chip. The Applicants submit that Figure 82 represents evidence of reduction to practice of the invention as claimed in Claim 19 before the June 29, 2001 filing date of Visser.

On the basis of the declaration, invention disclosure and the Final Report, Applicants submit that Visser can not be considered prior art to the present invention because the present invention was reduced to practice before the filing date of Visser. As a consequence, Applicants submit that the Examiner cannot make a *prima facie* § 102(a) rejection against claim 19 based on Visser. Reconsideration is respectfully requested.

It should be noted that claim 19 is related to a device. "For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose ... If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability." See *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860. See also MPEP 2138.05 (Requirements

to Establish Actual Reduction to Practice). Applicants submit that the enclosed Affidavit and supporting evidence clearly show that the device of claim 19 was successfully reduced to practice prior to the June 29, 2001 filing date of Visser.

The enclosed declaration is signed by less than all named inventors of the present application. A further declaration is enclosed with the present response, showing that one of the inventors is unavailable. See MPEP 715.04.

* * *

Applicants submit that all claims of the application are in condition for allowance. Prompt issuance of a Notice of Allowance is earnestly solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 on

June 16, 2005

(Date of Deposit)

Susan Papp

(Name of Person Depositing)

Susan Papp

06/16/05

Signature
Date

Respectfully submitted,



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Enclosures:

- Declaration of prior invention under 37 CFR 1.131
- Invention disclosure
- Pages from the Final Report
- Postcard